



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/650,467

08/28/2003

David E. Lowery

28341/6223.NDV1

7308

4743

7590

06/28/2006

MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER

ULM, JOHN D

ART UNIT

PAPER NUMBER

1649

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/650,467	Applicant(s) LOWERY ET AL.	
	Examiner John D. Ulm	Art Unit 1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-76 is/are pending in the application.
- 4a) Of the above claim(s) 56-68 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 69-76 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/24/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1649

1) Claims 56 to 76 are pending in the instant application.

2) Claims 56 to 68 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 06 March of 2006. The traversal is on the ground(s) that "the examiner has not shown how the products of Groups II and III would be materially different from a naturally expressed protein or a cell naturally expressing the recited protein.

This is not found persuasive because, if the claimed products are not materially different from a protein and cell as they occur in nature, then the claimed compositions are not subject to patentability under 35 § U.S.C. 101 since they would be neither new nor the invention of Applicant.

Applicant has further traversed the requirement on the ground(s) that a search of the different inventions in a single application would pose no undue burden. This is not found persuasive because M.P.E.P. 803 states that:

" For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant."

Serious burden was shown in the original requirement by the separate classification and separate status in the art of the different inventions. Applicant has provided neither a

showing nor evidence to the contrary. Applicant's assertion that the "examiner has failed to establish a *prima facie* case in support of restriction between Groups II and III because the examiner has failed to establish how the claimed products of Group III are different from the products of Group II" and that "the examiner has mischaracterized invention III as being drawn to an isolated protein" is clearly unpersuasive. Applicant has apparently chosen not to read their own claims. Group II, claim 68, is drawn to "an isolated GPCR-like receptor". Group III, as illustrated by claim 69, is drawn to "an isolated polynucleotide". A "receptor" is a protein, a "polynucleotide" is not. Applicant is advised that any argument that clearly ignores the facts of record is not going to be persuasive.

The requirement is still deemed proper and is therefore made FINAL.

3) The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code in line 27 on page 10, in line 11 on page 31 and in line 28 on page 73, for examples. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01(p), which states that:

"When a patent application with embedded hyperlinks and/or other forms of browser-executable code issues as a patent (or is published as a patent application publication) and the patent document is placed on the USPTO web page, when the patent document is retrieved and viewed via a web browser, the URL is interpreted as a valid HTML code and it becomes a live web link. When a user clicks on the link with a mouse, the user will be transferred to another web page identified by the URL, if it exists, which could be a commercial web site. USPTO policy does not permit the USPTO to link to any commercial sites since

the USPTO exercises no control over the organization, views or accuracy of the information contained on these outside sites. If hyperlinks and/or other forms of browser-executable code are embedded in the text of the patent application, examiners should object to the specification and indicate to applicants that the embedded hyperlinks and/or other forms of browser-executable code are impermissible and require deletion."

Correction is required.

4) The figure in the instant application does not comply with 37 C.F.R. § 1.84(U)(1), which states that "[where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG" must not appear".

5) The disclosure is objected to because text is missing from line 3 on page 5.

Appropriate correction is required.

6) The instant specification does not comply with 37 C.F.R. § 1.821(d) which requires a reference to a particular sequence identifier (SEQ ID NO:) be made in the specification and claims wherever a reference is made to that sequence. Table 5 on pages 24 and 25 of the instant specification discusses a plurality of amino acid sequences without employing the required sequence identifiers. Correction is required. See M.P.E.P. 2422.03.

7) Table 6 presented on page 34 of the instant specification does not comply with 37 C.F.R. 1.52 (C) with respect to font size. 37 C.F.R. 1.58 (c) states that:

Chemical and mathematical formulae and tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulae or tables may be placed in a

Art Unit: 1649

landscape orientation if they cannot be presented satisfactorily in a portrait orientation.

Typewritten characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which are at least 0.21 cm. (0.08 inch) high (e.g., elite type). A space at least 0.64 cm. (1/4 inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

Correction is required.

- 8) Claims 69 to 76 are allowable as written.

This application is in condition for allowance except for the presence of claims 56 to 68, directed to an invention non-elected with traverse in the reply filed on 06 March of 2006. Applicant is given **ONE MONTH or THIRTY DAYS** from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).


The prosecution of this case is closed except for consideration of the above matters.

.Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (571) 272-0880. The examiner can normally be reached on 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1649

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JOHN ULM
PRIMARY EXAMINER
GROUP 1800